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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/621,829

07/17/2003

Volker Klaus Null

TS-9504 (US)

1992

23632

7590

06/09/2006

SHELL OIL COMPANY

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EXAMINER

LEE, RIP A

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 06/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/621,829	<b>Applicant(s)</b> NULL, VOLKER KLAUS	
	<b>Examiner</b> Rip A. Lee	<b>Art Unit</b> 1713	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 March 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4,13,14 and 21-57 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4,13,14,21-28,37,39,41 and 43-45 is/are allowed.
- 6) ☒ Claim(s) 29-32,34-36 and 47-52 is/are rejected.
- 7) ☒ Claim(s) 33, 38, 40, 42, 46, 47 and 53-57 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>03-23-2006</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This office action follows a response filed on March 23, 2006. Claims 4 and 13 were amended, and new claims 21-57 were added. Claims 4, 13, 14, and 21-57 are pending.

#### ***Claim Objections***

1. Claim 38 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 33. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Both are drawn to essentially the same composition comprising Fischer-Tropsch derived oil having a sulfur content of 5 ppm or less and a nitrogen content of 1 ppm or less.
2. Claim 47 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 31. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Both are drawn to essentially the same composition comprising 0.1-10 wt % of Fischer-Tropsch derived oil having a pour point below -10 °C.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 30, 32, 34, and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "clear" in claim 30 is a relative term which renders the claim indefinite. The term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Since claims 32, 34, and 36 depend from claim 30, they are subsumed under the rejection.

***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Migchels *et al.* (U.S. 6,451,865).

Migchels *et al.* discloses oil gel compositions comprising copolymers of polystyrene. The oil component may be an oil prepared by Fischer-Tropsch synthesis (col. 7, line 23). Although the examples section of the disclosure does not show such an embodiment, it would have been obvious to one having ordinary skill in the art to use Fischer-Tropsch derived oil for preparing oil gel compositions of the invention because the inventors instruct the skilled artisan to do so. Since this combination is contemplated by the inventors, one of ordinary skill in the art would have expected such an embodiment to work.

7. Claims 29, 31, and 47-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Migchels *et al.* in view of O'Rear *et al.* (U.S. 6,562,230).

Migchels *et al.* is silent with respect to the nature of the Fischer-Tropsch oil for practicing the invention. O'Rear *et al.* teaches Fischer-Tropsch oils having having pour points in the temperature range of -15 to -40 °C (claim 14). Absent any showing of criticality, one of ordinary skill in the art would have found it obvious to use the oils disclosed in O'Rear *et al.* in the invention of Migchels *et al.*, and thereby arrive at the subject matter of the instant claims. According to O'Rear *et al.*, the oils have a kinematic viscosity of at least 5 mm<sup>2</sup>/s at 40 °C. Although the kinematic viscosity is not measured at 100 °C, a reasonable basis exists to believe that the oils disclosed in the patent exhibit the recited kinematic viscosity at elevated temperature. Since the PTO can not perform experiments, the burden is shifted to the Applicants to establish an unobviousness difference. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

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8. Claims 29 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gapinski (U.S. 2004/0110647).

The invention of Gapinski relates to a composition comprising a styrene/maleic acid copolymer and 10 wt % of lubricating oil. According to the inventor, suitable oils are those that are prepared by Fischer-Tropsch synthesis. Although the examples section of the disclosure does not show such an embodiment, it would have been obvious to one having ordinary skill in the art to use Fischer-Tropsch derived oil for preparing oil gel compositions of the invention because the inventor instructs the skilled artisan to do so. Since this combination is contemplated by the inventor, one of ordinary skill in the art would have expected such an embodiment to work.

9. Claims 29, 31, 35, and 47-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gapinski (U.S. 2004/0110647) in view of O'Rear *et al.*

Gapinski is silent with respect to the nature of the Fischer-Tropsch oil for practicing the invention. O'Rear *et al.* teaches Fischer-Tropsch oils having having pour points in the temperature range of -15 to -40 °C (claim 14). Absent any showing of criticality, one of ordinary skill in the art would have found it obvious to use the oils disclosed in O'Rear *et al.* in the invention of Migchels *et al.*, and thereby arrive at the subject matter of the instant claims. According to O'Rear *et al.*, the oils have a kinematic viscosity of at least 5 mm<sup>2</sup>/s at 40 °C. Although the kinematic viscosity is not measured at 100 °C, a reasonable basis exists to believe that the oils disclosed in the patent exhibit the recited kinematic viscosity at elevated temperature. Since the PTO can not perform experiments, the burden is shifted to the Applicants to establish an unobviousness difference. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

10. For purposes of filing out PTO-326, claims 40, 42, and 46 are also objected to since these claims depend from objected claim 38.

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11. Claims 33 and 53-57 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. The following is a statement of reasons for the indication of allowable subject matter: Claims 4, 13, 14, 21-28, 37, 39, 41, and 43-45 are allowed over the references cited to date. None of the references teaches the composition of the claims. One of ordinary skill in the art would have no reasonable basis to believe that the oils described in the references inherently possess the recited properties.

### ***Response to Arguments***

13. The rejections of claims over Heemann *et al.* (U.S. 2003/0105259), Koblitz *et al.* (U.S. 5,360,350), and Makowski *et al.* (U.S. 3,927,143) have been overcome by amendment.

### ***Conclusion***

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (571)272-1104. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<http://pair-direct.uspto.gov>>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

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June 6, 2006



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